

Question Q217

National Group: Chile

Title: The patentability criterion of inventive step/non-obviousness

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Date:

Questions

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

The standard for inventive step is given by the legal definition of Article 35 of our legislation on patents of invention, that defines it as:

Article 35.- "It is considered that an invention has inventive step if, for a person skilled in the art, it is not obvious or evidently derived from the prior art"

When performing the inventive step analysis, the examiner must give his/her opinion on the compliance of this requirement on each one of the claims, taking into account the degree of knowledge that existed in the respective technical area.

Within the guidelines adopted by the Chilean Patent Office, is the one that follows the "problem-solving" method to determine the inventive step.

In general terms, the standard proposed by the CLPTO is based on three steps:

- a. Determining of the closest prior art.
- b. Establishing the technical problem being solved.
- c. Analysis of the invention obviousness.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

During the last 20 years there has been some changes as, from September 1991, our legislation has explicitly incorporated the concept of inventive step as one of the basic requirements that an invention must comply with.

This inventive step notion has been kept for the last 20 years but new guidelines and practices have been incorporated that have allowed us to get closer to international standards.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

Yes, our patent-granting authority does publish examination guidelines on inventive step notions but as they are issued fairly recently, we feel that, although they are useful, it is perhaps too soon to give a final evaluation on them.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

The standard for inventive step/non-obviousness does not differ during examination or invalidity proceedings of the patent as they are only performed by the CLPTO. They do differ during litigation for infringement known by the ordinary tribunals that analyse this matter with more flexibility as, apart from the technical considerations, a Judge could also consider some commercial aspects.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

The reading and interpretation of a claim is not made literally but just as it would be understood by a person skilled in the corresponding technical area.

6. Is it possible to read embodiments from the body of the specification into the claims?

Different articles of our IP Law and its body of regulations that demand clarity and concision in the claims, make it impossible to read embodiments from the body of the specification into the claims.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

Prior art is interpreted just as it would be understood by a person skilled in the corresponding technical area and he/she should take into consideration the inherent or implicit disclosures, as a type of disclosure that is effectively part of the prior art.

8. Do the answers to any of the questions above differ during examination versus during litigation?

During the applications prosecution process, in general, the technical considerations are the ones that are used for the inventive step analysis. However, in litigation issues, apart from the technical considerations, a Judge could consider the commercial aspects, such as for example, the acceptance of a product in the market *versus* the prior art products.

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference?

Yes.

If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)?

It is required the knowledge of a person skilled in same field than the one of the application.

Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

Yes.

The inventive step analysis in Chile is made with the problem-solving method, similarly to the one used by the European Patent Office but complying, in some aspects, to the USPTO corrected practice.

Accordingly, a person skilled in the art will analyse the closest document to the invention and will evaluate, after following a series of stages, if it could achieve the same technical results than the application, having as a starting point said document, using to that end his/her own expertise and degree of creativity plus all the teachings from the prior art.

Therefore, it is perfectly possible to find a lack of inventive step based only on one document from the prior art plus the teachings of the previous art.

In the case that an analysed claim is novel, the missing teaching for the invention to be found as lacking of inventive step or "obvious", could be the union between a relevant

document plus the common general knowledge that a person skilled in the art would have in the matter previous to the filing date of the application or to its priority date.

So just give arguments as the only element to justify the lack of inventive step is not enough because the problem-solving method requires as a first step the determining of the closest prior art.

Therefore, it becomes clear that the level of general knowledge of a person skilled in the art is a variable that must be considered when determining the inventive step.

10. What is required to combine two or more prior art references?

To combine two or more prior art references it is required that they have the greater number of characteristics and technical results in common with the invention, just as this one has been claimed in the application.

Is an explicit teaching or motivation to combine required?

Yes.

At the moment, the two criteria have been used, the explicit teaching and the motivation to combine the disclosed contents of both documents.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed?

The documents should be within the same claimed technical field.

How relevant is the problem the inventor of the claim in question was trying to solve?

Is very relevant, as article 31 of IP law recites: "Is defined as an invention every solution to a problem of the prior art that originates an industrial activity".

The problem to be solved by the invention is totally relevant and basic in the use of the "problem-solving" method used in Chile.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

It is not allowed to combine more than two prior art references simultaneously. If in a search report there are more than two documents that are relevant for the inventive step analysis, always those documents will have to be combined in pairs, so that the Examiner can give a pronouncement on this patentability requirement.

13. Do the answers to any of the questions above differ during examination versus during litigation?

At the examination stage, normally an Examiner will not consider as a "surprising effect" a commercial condition. However, this opinion could be different when there is a legal dispute.

Technical Problem

14. What role, if any, does the technical problem to be solved plays in determining inventive step or non-obviousness?

Generally, the technical problem plays a main role in determining the inventive step or non-obviousness. Although when the inventive step is analysed in relation to compounds (chemical molecules) which are structurally very close to the prior art compounds, the technical problem is not considered at all.

Therefore, in these cases it is considered that the application lacks of inventive step, independently of the technical problem that is being solved.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

The technical problem must be explicitly and clearly disclosed, identified or described.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

Advantageous effects play a main role in determining inventive step or non-obviousness. Generally, an advantageous effect is an indication of inventive step.

17. Must the advantageous effects be disclosed in the as-filed specification?

Yes, the advantageous effects must be disclosed in the as-filed specification.

18. Is it possible to have later-submitted data considered by the Examiner?

Yes, it is possible to have later-submitted considered by the Examiner, even more so if such data compares the invention with the closest prior art.

Chilean regulations establish that the Examiner can request, if it is needed, some additional information to third parties, such as laboratories tests results, for example, resistance test for materials, when deciding a pronouncement on the patentability requirements of an application, so as to determine the surprising effect of the invention.

19. How "real" must the advantageous effects be? Are paper or hypothetical examples sufficient?

Generally, hypothetical examples would be sufficient if they is a contribution with quantitative data to back up the advantageous results. In other words, it is not absolutely necessary a "complete" description as to how the tests were made or implemented, as the resulting data is relevant *per se*.

20. Do the answers to any of the questions above differ during examination versus during litigation?

In the examination stage, normally an Examiner will not consider as a "surprising effect" a commercial condition. However, this opinion can differ when there is legal dispute.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favour of inventive step / non-obviousness? Must the teaching be explicit?

There are no special clauses in our industrial property legislation that specifically refer to the "teaching away" as an analysing element of the inventive step, in spite of being a criterion to be considered on the examiner's part.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

As previously said, the concept of "teaching away" has not been clearly recognized as an alternative in our legislation nor it is part of the CLPTO's administrative jurisprudence, therefore, to this day, its relative importance in our jurisdiction cannot be evaluated.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

As already explained, the "teaching away" is not an evaluation element of the inventive step that has received a specific acknowledgment in our legislation or in the administrative jurisprudence or in our courts, therefore, it is not possible to reply to this question.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

Yes, but it will depend of the circumstances that surround the invention. These considerations are used as indicators of obviousness and non-obviousness when the invention is analysed.

The commercial or motivational considerations are considered more in litigation cases than in the technical analysis performed by an examiner.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the claimed invention and the secondary considerations required?

As in the case with all pieces of evidence, they should be provided and considered in their own merit. The closest connection between the claimed invention and the secondary considerations is certainly required.

26. Do the answers to any of the questions above differ during examination versus during litigation?

Yes. As indicated in No. 24 above, secondary considerations are more valuable during litigation than at the examination stage.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step/non-obviousness in your jurisdiction?. If yes, please describe these issues, tests, or factors.

For patents related to compounds (chemical molecules), in the majority of cases it is considered how close is a compound compared to a previous art compound. That is to say, if minor differences are found between a compound when compared with a compound close to the prior art, generally the inventive step will not be recognized, independently of which technical problem is being solved by the invention and the previous art.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.

There is no defined protocol in the law or its regulations for the realization of tests or laboratories tests.

29. Does such test differ during examination versus during litigation?

It can differ between the examination of the patent application and a litigation process, given that a Judge has greater authority than an Examiner. A Judge could require, for example, to have the opinion and tests reports of organizations such as, for example; universities, laboratories, etc.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

There are no other areas.

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

Yes. Normally ordinary tribunals are not specialized in IP matters, something that could result in that the court misinterpret important arguments when deciding on a case.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge

in their approach to inventive step / non-obviousness?

N/A

33. If yes, is this problematic?

N/A